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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/520,264

Applicant(s)

WEAVER ET AL.

Examin r

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 50-97 is/are rejected.
- 7) ☐ Claim(s) 60-63, 69-78, 82, 83 and 85-97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>12/08/2004</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

R s p o n s t o A m e n d m e n t

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 09/09/2004 has been entered.

This is in response to amendment filed on 09/09/2004.

Claims 50-97 are pending for examination, claims 1- 49 have been previously canceled; claims 50, 52, 55, 56, 58-60, 62, 64-65, 68-71, 73-79, 81-85, 87, 91 and 94 have been amended and claims 96-97 have been newly added.

A telephone interview initiated by Applicant's attorneys (Ellen M. Bierman and Dennis M. de Guzman) has been conducted on December 8, 2004 between Examiners (Uyen Le and Susan Chen). Please refer to the Interview Summary for details.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 50 (line 9), 69 (line 11), 75 (line 12), 79 (line 8) and 85 (line 10), it is unclear what does the indexing or index metadata refer to [i.e., the instant specification has the support to store and use metadata as index to perform file retrieving operations (e.g., Page 7, lines 23 – Page 8, line 1; Page 19, line 6-10, 14-17), but fails to provide any algorithm to index metadata]. Furthermore, there are a plurality of storage mediums in the instant specification, the claim language fails to clearly points out where the received electronic files and metadata are being stored.

As to claims 51-68, 70-74, 76-78, 80-84 and 86-97, these claims have the same defect as their base claims 50, 69, 75, 79 and 85, hence are rejected for the same reason.

Because the ambiguous nature of the claim language, the following art rejection is to the best of the examiner understanding.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50-59, 64-68, 79-81 and 84, are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. Patent. No. 5,813,009).

As to claim 50, Johnson discloses a method in a computer system [e.g. Abstract, Fig(s). 1-8 and associated texts] for analyzing data produced for legal purposes comprising:

a) receiving, from an external information system [e.g., the External Incoming Information system, Fig. 1A] that is external to the computer system [e.g., the information Location Management (ILM) system, col. 5, line 67], a plurality of electronic files [e.g., col. 7, lines 31-55] that are stored in a data structure arranged according to a directory structure [e.g., the file structure of cases, folders, document, etc., and the defined path for location information, col. 31, lines 1-10] that are subject to a legal proceeding [e.g., col. 14, lines 26-30];

b) storing the received electronic files in a searchable format [e.g., store Pre-Certified Data from ILM Capture to ILM database, Fig. 1C];

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c) storing and indexing metadata [e.g., the tags, col. 11, lines 29-32, col. 12, lines 49-50, 59-64] associated with the received electronic files [e.g., col. 11, lines 25-32] while preserving directory structure information of the received data structure [e.g., Cabinets the defined path for location information, col. 31, lines 7-8];

d) receiving a request for electronic files having a specified characteristic [e.g., col. 4, lines 49 – 59, col. 11, lines 2-8];

e) processing the metadata to determine a set of electronic files having the specified characteristic [e.g., col. 11, lines 2-49], thereby facilitating processing of the determined set of electronic files for legal purposes [e.g., col. 7, lines [e.g., col. 21, lines 35-38].

As to claims 51-52, except the features as recited in claim 50, Johnson further discloses that the returning the indication of the determined set of electronic files includes returning a list of electronic files that contain content that matches the specified characteristic [e. g., col. 10, lines 12-20, col. 11, lines 27-32].

As to claim 53, except the features as recited in claims 50, Johnson further discloses that the method of storing and indexing the metadata including storing and indexing the metadata in a database [e.g., col. 13, lines 7-65].

As to claim 54, except the features as recited in claim 50, Johnson further discloses that the received electronic files is stored in a searchable text format [e.g., col. 16, lines 31 – col. 17, line 4].

As to claim 55, except the features as recited in claim 50, Johnson further discloses that legal proceeding is a discovery proceeding that is part of a lawsuit, a mergers, an acquisitions proceeding or a due diligence effort [e.g., Abstract, lines 22-27, col. 26, lines 34-44; col. 27, lines 6-17].

As to claim 56, except the features as recited in claim 50, Johnson further discloses the following as claimed:

a) the electronic files produced by at least one party involved in the legal proceeding [e.g., col. 26, line 34-44, the audit loggings, col. 26, line 65 – col. 27, line 17];

b) receiving from the information system [e.g., the External In-Coming Information system, Fig. 1A] that is external to the computer system [e.g., the ILM Information Filter, Fig. 1A] for analyzing data for legal purposes [e.g., Abstract, lines 22-25], at least some electronic files [e.g., Audit Logging, col. 26, line 64] that have been previously exchanged between the at least one party [e.g. the Off-site party, Fig. 1C] and another party prior [e.g., the Disposal party, Fig. 1C] prior to the legal proceeding, the external information system belonging to the at least one party of the legal proceeding [e.g., the court of law, col. 27, line

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11] and having stored therein these electronic files, [e.g., col. 27, lines 6-17, Fig.(s) 1-Fig. 4 and associated texts].

c) wherein, the plurality of electronic files are received at the computer system during the legal proceeding, the computer system not belonging to any party of the legal proceeding [e.g., the ILM system does not belong to the Off-site system, Fig. 1C].

As to claim 57, except the features as recited in claim 50, Johnson further discloses that the method of storing and indexing metadata associated with the received electronic files includes storing and indexing threading information associated with the emails [e.g., col. 18, lines 63- col. 19, line 14].

As to claim 58, except the features as recited in claim 50, Johnson further discloses that the method of receiving the plurality of electronic files including receiving word-processing file from the external information system [e.g., col. 8, lines 57-59].

As to claim 59, except the features as recited in claim 50, Johnson further discloses that the method of storing and indexing metadata associated with the received electronic files including storing and indexing metadata associated with a native format of the received electronic files [e.g., col. 10, lines 65 – col. 11, lines 8; col. 15, lines 47-50].

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As to claims 64 -65, except the features as recited in claim 50, Johnson further discloses that providing a user interface to display and apply at least one of the annotations [e.g., col. 19, lines 50-58] including a responsive preparation selections to the electronic files having the specified characteristic and that are responsive to the request [e.g., col. 15, lines 9-67, col. 28, lines 31- col. 30, line 64].

As to claims 66-67, except the features as recited in claim 50, Johnson further discloses that providing a summary information [e.g., the archived catalogue, col. 18, lines 4-6] indicative of electronic files that are available to be searched and processed to determine the set of electronic files having the specified characteristic [e.g., Fig. 4 and associated texts].

As to claim 68, except the features as recited in claim 50, Johnson further discloses that receiving a request that specifies at least one of the properties information associated with the electronic file [e.g., the speed keys processing based on user's request, col. 19, lines 25-31].

As to claims 79-81 and 84 these claims recite the same features as claims 50-59 and 64-68 in form of computer system, hence are rejected for the same reason.

Allowable Subject Matter

Claims 69-78 and 85-97 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 60-63 and 82-83 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 60-63, 69-78, 82-83 and 85-97 having allowable subject matter because the prior art on record or that encountered in searching for the invention fails to disclose or suggest the features of instant invention – recursively extracting from a data structure having a plurality of electronic files provided from an external system and subject to a legal proceeding in a combination as claimed by applicant.

Response to Arguments

Applicant's arguments with respect to claims 50-97 have been considered but are moot in view of the new ground(s) of rejection.

C nclusion

To expedite the process of examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ricart et al. (U.S. Patent No. 6,795,835) which discloses migration of computer personalization information when network is not available;

Henits (U.S. Patent No. 6,775,372) which discloses system and method for multi-stage data logging and distribution via interfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

December 10, 2004



UYEN LE
PRIMARY EXAMINER